

## **REMARKS**

### **I. Claims 24-34 are Allowable**

The Office has rejected claims 24-34 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 24-34 as currently amended are directed to statutory subject matter of a “computer program product”, as recited in claim 24. Hence, claims 24-34 are allowable.

### **II. Claims 1-5, 7, 9, 12-13, 18, 24-28, and 30-36 are Allowable**

The Office has rejected claims 1-5, 7, 9, 12-13, 18, 24-28, 30-36, at paragraph 6 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm User’s Manual (“OmniForm”), in view of Quality Reexamination Review Sheet (“QRSS”). Applicants respectfully traverse the rejections.

None of the cited references, including OmniForm and QRSS, disclose or suggest the specific combination of claim 1. For example, QRSS does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1 and as stated by the Office, the “QRSS is a USPTO quality review sheet comprising a paper input form (page 1).” *See Action*, page 3, paragraph 6. Further, the QRSS states, “its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding.” *See QRSS*, paragraph 1. Accordingly, QRSS is directed to only “quality review” in the “reexamination proceeding.” The QRSS discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See Action*, page 3-4. The Office stated that the input to questions 1-8 is regarding criteria for infringement. *See Action*, page 3-4. However, a quality review of a reexamination proceeding as described by QRSS does not disclose “posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 1. In contrast to claim 1, QRSS does not display any type of infringement criteria for a

particular patent. Rather, the user must take the affirmative step of “inputting explanations and/or comments” to questions 1-8 of the form. *See Action*, page 4.

The Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See Action*, page 21, paragraph 13. However, the results of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the results of a patent infringement suit is not determinative of the results of a reexamination process. QRSS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See QRSS*, questions 1-8.

When the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.

*See 35 U.S.C. §305*

Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a valid patent. QRSS does not pertain to identifying an infringement target, but rather pertains to reexamination.

The Office stated that QRSS accepts user entry of a Control Number, which the Office states is an “infringement target”, as recited in claim 1. However, the Control Number pertains to a reexamination procedure rather than an infringement target. Moreover, QRSS only allows entry of a single Control Number. The QRSS does not disclose “a particular patent” and “an infringement target”, as recited in claim 1.

In addition, OmniForm does not disclose or suggest the elements of claim 1 not disclosed by QRSS. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See OmniForm*, p. 1, paragraph 1. Therefore, QRSS and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 1. Hence, claim 1 is allowable.

Claims 2-5, 7, 9, 12-13, 18, and 35 depend from claim 1, which Applicants have shown to be allowable. Therefore, QRSS and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 2-5, 7, 9, 12-13, 18, and 35. Accordingly, claims 2-5, 7, 9, 12-13, 18, and 35 are also allowable, at least by virtue of their dependence from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRSS nor OmniForm disclose or suggest an electronic form including a plurality of input boxes “to receive a portion of the second user input that describes how an infringement target meets the respective one of the criteria” for infringement of a particular patent, as recited in claim 4. In contrast to claim 4, QRSS discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See* QRSS, questions 1-8. Any comments/explanations are related to that single patent. Accordingly, the Control Number of QRSS cannot represent both a “particular patent” and “an infringement target” of that particular patent. Further, QRSS does not disclose “a second user input that describes how the infringement target meets the respective one of the criteria”, as recited in claim 4. Rather, any input by QRSS is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest this element of claim 4. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 4 is allowable.

Neither QRSS nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 12, or that evaluating is performed by a patent attorney, as recited in claim 13. The Office stated “many employees dealing with reexamination at the USPTO have law degrees.” *See* Action, page 22. However, employees at the USPTO do not evaluate “the infringement submission”, as recited in claims 12 and 13. Further, QRSS is a form including questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRSS, questions 1-8. QRSS does not address evaluating an infringement submission, or involvement of a patent attorney in evaluating an infringement submission. In contrast to claims 12 and 13, QRSS discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See* QRSS,

questions 1-8. Any comments/explanations are related to that single patent. Accordingly, QRSS does not disclose “evaluating the infringement submission based on the first user input and the second user input”, as recited in claim 4. Rather, any input by QRSS is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest these elements of claims 12 and 13. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For these additional reasons, claims 12 and 13 are allowable.

None of the cited references, including OmniForm and QRSS, disclose or suggest the specific combination of claim 24. For example, QRSS does not disclose to “display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 24. In contrast to claim 24, QRSS is a USPTO quality review sheet comprising a paper input form (page 1). Further, QRSS states, “its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding.” *See* QRSS, paragraph 1. Accordingly, QRSS is directed to only “quality review” in the “reexamination proceeding.” The QRSS discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See* Action, pages 3-4. However, a quality review of an examination proceeding as disclosed by QRSS does not disclose “an electronic form to display criteria for infringement of a particular patent”, as recited in claim 24. In contrast to claim 24, QRSS does not display any type of infringement criteria for a particular patent.

As discussed above, the Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See* Action, page 21, paragraph 13. However, the result of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the result of a patent infringement suit is not determinative of the results of a reexamination process. QRSS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRSS, questions 1-8.

Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a valid patent. QRSS does not pertain to identifying an infringement target, but rather pertains to reexamination. Moreover, QRSS only allows entry of a single Control Number. QRSS does not disclose “a particular patent” and “an infringement target”, as recited in claim 24. In addition, OmniForm does not disclose or suggest the elements of claim 24 not disclosed by QRSS. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRSS and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 24. Hence, claim 24 is allowable.

Claims 25-28 and 30-34 depend from claim 24, which Applicants have shown to be allowable. Hence, QRSS and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 25-28 and 30-34. Accordingly, claims 25-28 and 30-34 are allowable, at least by virtue of their dependence from claim 24.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRSS nor OmniForm disclose or suggest an electronic form including a plurality of input boxes to receive a portion of the second user input that describes how an infringement target meets a respective one of the criteria for infringement of a particular patent, as recited in claim 27. In contrast to claim 27, QRSS discloses questions pertaining to whether a reexamination proceeding is considered deficient and does not disclose requiring input that describes infringement. *See* QRSS, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 27. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 27 is allowable.

None of the cited references, including OmniForm and QRSS, disclose or suggest the specific combination of claim 36. For example, QRSS does not disclose “posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria”, as recited in claim 36. In contrast to claim 36, QRSS is a USPTO

quality review sheet comprising a paper input form. Further, QRSS states, “its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding.” *See* QRSS, paragraph 1. Accordingly, QRSS is directed to only “quality review” in the “reexamination proceeding.” QRSS discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See* Action, pages 3-4. However, a quality review of an examination proceeding as disclosed by QRSS does not disclose “posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 36. In contrast to claim 36, QRSS does not display any type of infringement criteria for a particular patent.

As discussed above, the Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See* Action, page 21, paragraph 13. However, the result of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the result of a patent infringement suit is not determinative of the results of a reexamination process. QRSS discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRSS, questions 1-8.

Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a patent. QRSS does not pertain to identifying an infringement target, but rather pertains to reexamination. Moreover, QRSS only allows entry of a single Control Number. QRSS does not disclose “a particular patent” and “an infringement target”, as recited in claim 36. In addition, OmniForm does not disclose or suggest the elements of claim 36 not disclosed by QRSS. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1.

Further, neither QRSS nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 36. Still even further, QRSS is simply a form including questions pertaining to whether a reexamination

proceeding is considered deficient. *See* QRSS, questions 1-8. QRSS does not address evaluating an infringement submission. In contrast to claim 36, QRSS discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See* QRSS, questions 1-8. Any comments/explanations are related to that single patent. Accordingly, QRSS does not disclose “evaluating the infringement submission based on the first user input and the second user input”, as recited in claim 36. Rather, any input by QRSS is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest these elements of claim 36. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRSS and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 36. Hence, claim 36 is allowable.

### **III. Claims 6, 19 and 29 are Allowable**

The Office has rejected claims 6, 19 and 29, at paragraph 7 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRSS, and further in view of BountyQuest Website (“BountyQuest”). Applicants respectfully traverse the rejections.

As explained above, OmniForm and QRSS do not disclose all of the elements of claim 1. BountyQuest does not disclose or suggest the elements of claim 1 not disclosed or suggested by OmniForm and QRSS. For example, BountyQuest does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, BountyQuest is directed to invalidating a patent by identifying prior art that does predate the filing of a particular patent. *See* BountyQuest website, p. 9. As stated by the Office, “[i]nfringement of a patent can only occur if the claimed ‘infringement target information’ does not predate the filing date of the particular patent.” *See* Action, page 22. Accordingly, BountyQuest does not disclose “infringement target information” because prior art identified by BountyQuest cannot infringe a patent but prior art can invalidate a patent. Moreover, the corresponding text input adjacent to the “criteria for invalidity” of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See* BountyQuest, p. 16. However, BountyQuest does not disclose “posting an electronic form that displays criteria for infringement

of a particular patent", as recited in claim 1. Therefore, OmniForm, QRSS, and BountyQuest, separately or in combination, do not disclose each and every element of claim 1, or of claims 6 and 19, which depend from claim 1. Therefore, claims 6 and 19 are allowable.

Further, the dependent claims recite additional features not disclosed by the cited references. For example, QRSS does not disclose that each claim limitation is associated with one of a plurality of display portions and one of the plurality of input boxes, as recited in claim 6. In contrast to claim 6, QRSS presents questions pertaining to deficiencies in a reexamination, and has no display portions or input boxes associated with claim limitations. *See* QRSS, questions 1-8. Further, the Office states that OmniForm does not disclose this element of claim 6. BountyQuest, in contrast to claim 6, includes a form in which a user supplies information about prior art that may invalidate a particular patent, and not criteria for infringement of a particular patent, as recited in claim 6. *See* BountyQuest website, p. 16. For this additional reason, claim 6 is allowable.

Further, QRSS does not disclose sending, to the user, a message to acknowledge receipt of the infringement submission, the message indicating the date and the time associated with the infringement submission, as recited in claim 19. Instead, QRSS is a form pertaining to whether a reexamination proceeding is considered deficient. *See* QRSS, questions 1-8. Further, the Office states that OmniForm does not disclose this element of claim 19. In contrast to claim 19, BountyQuest pertains to submitting prior art that predates a particular patent and may invalidate a patent. *See* BountyQuest website, p. 9. BountyQuest does not serve to identify infringers of valid patents. For this additional reason, claim 19 is allowable.

As explained previously, OmniForm and QRSS do not disclose all of the elements of claim 24. BountyQuest does not disclose or suggest the elements of claim 24 not disclosed or suggested by OmniForm and QRSS. For example, BountyQuest does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, BountyQuest is directed to invalidating a patent and identifying prior art

that predates a particular patent. *See* BountyQuest website, p. 9. Therefore, OmniForm, QRSS, and BountyQuest, taken separately or in combination, do not disclose each and every element of claim 24, or of claim 29, which depends from claim 24. Therefore, claim 29 is allowable.

#### **IV. Claims 10-11, 14-17, and 20 are Allowable**

The Office has rejected claims 10-11, 14-17, and 20, at paragraph 8 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRSS, and further in view of European Patent No. EP 1 160 708 (“Utsumi”). Applicants respectfully traverse the rejections.

As explained previously, OmniForm and QRSS do not disclose or suggest each element of claim 1. Utsumi does not disclose the elements of claim 1 not disclosed by OmniForm and QRSS. For example, Utsumi does not disclose “posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 1. In contrast to claim 1, Utsumi discloses a website that displays an application number, an unexamined publication number, a registration number, the patent holder’s name, a technical field, an abstract, and claims of the patent. *See* Utsumi, column 4, lines 16; Figure 2. Utsumi does not disclose displaying “criteria for infringement of a particular patent”, as recited in claim 1. Rather, Utsumi discloses an information input window to receive information about an infringer. *See* Utsumi, column 5, lines 49-51. In contrast to claim 1, Utsumi does not disclose a “user input to describe how the infringement target meets the criteria” as recited in claim 1. In fact, Utsumi does not disclose any “criteria for infringement of a particular patent” as recited in claim 1. Therefore, the combination of OmniForm, QRSS, and Utsumi fails to disclose or suggest each and every element of claim 1, or of claims 10-11, 14-17, and 20, which depend from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRSS, OmniForm nor Utsumi disclose or suggest that compensating the user is conditioned on a deal with an infringement target, as recited in claim 15, or that compensating the user comprises providing the user a fee commensurate with compensation from a deal with the infringement target, as recited in claim 17. The Office states that OmniForm does not disclose these elements. In contrast to claims 15 and 17, QRSS is a

form to record deficiencies in a reexamination proceeding. In further contrast to claims 15 and 17, Utsumi discloses that an amount of a reward for information provided may be determined by patent attorneys and lawyers evaluating the information for effectiveness in substantiating the infringement, or that the amount may be a fixed fee. *See* Utsumi, paragraph 0044. Thus, in Utsumi, compensation may be determined by an evaluation of the potential effectiveness in an infringement suit, rather than conditioned on a completed deal with the infringement target, or commensurate with compensation from a completed deal with the infringement target. For at least this additional reason, claims 15 and 17 are allowable.

#### **V. Claims 1-5, 7, 9, 12-13, 18, 24-28, and 30-36 are Allowable**

The Office has rejected claims 1-5, 7, 9, 12-13, 18, 24-28, and 30-36, at paragraph 9 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm User's Manual ("OmniForm"), in view of Quality Review Reexamination ("QRRP1"). Applicants respectfully traverse the rejections.

None of the cited references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 1. For example, QRRP1 does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1 and as stated by the Office, the "QRRP1 is a USPTO quality review sheet comprising a paper input form (pages 1,2)." *See* Action, page 10, paragraph 9. Further, the QRRP1 states, "its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding." *See* QRRP1, paragraph 1. Accordingly, QRRP1 is directed to only "quality review" in the "reexamination proceeding." The QRRP1 discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See* Action, page 10. The Office stated that the input to questions 1-8 is regarding criteria for infringement. *See* Action, page 10. However, a quality review of an examination proceeding as disclosed by QRRP1 does not disclose "posting an electronic form that displays criteria for infringement of a particular patent", as recited in claim 1. In contrast to claim 1, QRRP1 does not display any type of criteria for a

particular patent unless the user takes the affirmative step of “inputting explanations and/or comments” to questions 1-8 of the form. *See* Action, page 10.

The Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See* Action, page 21, paragraph 13. However, the results of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the results of a patent infringement suit is not determinative of the results of a reexamination process. QRRP1 discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRP1, questions 1-8.

When the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.

*See* 35 U.S.C. §305

Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a valid patent. QRRS does not pertain to identifying an infringement target, but rather pertains to reexamination.

The Office states that the QRRP1 accepts user entry of a Control Number, which the Office states is an “infringement target” as recited in claim 1. However, the Control Number pertains to a reexamination procedure rather than an infringement target. Moreover, QRRP1 only allows entry of a single Control Number. The QRRP1 does not disclose “a particular patent” and “an infringement target”, as recited in claim 1.

In addition, OmniForm does not disclose or suggest the elements of claim 1 not disclosed by QRRS. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRP1 and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 1. Hence, claim 1 is allowable.

Claims 2-5, 7, 9, 12-13, 18, and 35 depend from claim 1, which Applicants have shown to be allowable. Therefore, QRRP1 and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 2-5, 7, 9, 12-13, 18, and 35. Accordingly, claims 2-5, 7, 9, 12-13, 18, and 35 are also allowable, at least by virtue of their dependence from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRP1 nor OmniForm disclose or suggest an electronic form including a plurality of input boxes “to receive a portion of the second user input that describes how an infringement target meets a respective one of the criteria” for infringement of a particular patent, as recited in claim 4. In contrast to claim 4, QRRP1 discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See* QRRP1, questions 1-8. Any comments/explanations are related to that single patent. Accordingly, the Control Number of QRRP1 cannot represent both a “particular patent” and “an infringement target” of that particular patent. QRRP1 does not disclose “a second user input that describes how the infringement target meets the respective one of the criteria”, as recited in claim 4. Rather, any input by QRRP1 is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest this element of claim 4. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 4 is allowable.

Neither QRRP1 nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 12, or that evaluating is performed by a patent attorney, as recited in claim 13. The Office stated “many employees dealing with reexamination at the USPTO have law degrees.” *See* Action, page 22. However, employees at the USPTO do not evaluate “the infringement submission”, as recited in claims 12 and 13. Further, QRRP1 is a form including questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRP1, questions 1-8. QRRP1 does not address evaluating an infringement submission, or involvement of a patent attorney in evaluating an infringement submission. In contrast to claims 12 and 13, QRRP1 discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See*

QRRP1, questions 1-8. Any comments/explanations are related to that single patent. Accordingly, QRRP1 does not disclose “evaluating the infringement submission based on the first user input and the second user input”, as recited in claim 4. Rather, any input by QRRP1 is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest these elements of claims 12 and 13. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For these additional reasons, claims 12 and 13 are allowable.

None of the cited references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 24. For example, QRRP1 does not disclose to “display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 24. In contrast to claim 24, the QRRP1 is a USPTO quality review sheet comprising a paper input form. Further, the QRRP1 states, “its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding.” *See* QRRP1, paragraph 1. Accordingly, QRRP1 is directed to only “quality review” in the “reexamination proceeding.” The QRRP1 discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See* Action, page 10. However, a quality review of an reexamination proceeding as disclosed by QRRP1 does not disclose “an electronic form to display criteria for infringement of a particular patent”, as recited in claim 24. In contrast to claim 24, QRRP1 does not display any type of infringement criteria for a particular patent.

As discussed above, the Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See* Action, page 21, paragraph 13. However, the result of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the result of a patent infringement suit is not determinative of the results of a reexamination process. QRRP1 discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See* QRRP1, questions 1-8.

Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a valid patent. QRRP1 does not pertain to identifying an infringement target, but rather pertains to reexamination. Moreover, QRRP1 only allows entry of a single Control Number. QRRP1 does not disclose “a particular patent” and “an infringement target”, as recited in claim 24. In addition, OmniForm does not disclose or suggest the elements of claim 24 not disclosed by QRRP1. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRP1 and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 24. Hence, claim 24 is allowable.

Claims 25-28 and 30-34 depend from claim 24, which Applicants have shown to be allowable. Hence, QRRP1 and OmniForm, taken separately or in combination, fail to disclose at least one element of each of claims 25-28 and 30-34. Accordingly, claims 25-28 and 30-34 are allowable, at least by virtue of their dependence from claim 24.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRP1 nor OmniForm disclose or suggest an electronic form including a plurality of input boxes to receive a portion of the second user input that describes how an infringement target meets a respective one of the criteria for infringement of a particular patent, as recited in claim 27. In contrast to claim 27, QRRP1 discloses questions pertaining to whether a reexamination proceeding is considered deficient and does not disclose requiring input that describes infringement. *See* QRRP1, questions 1-8. Further, OmniForm does not disclose or suggest this element of claim 27. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. For this additional reason, claim 27 is allowable.

None of the cited references, including OmniForm and QRRP1, disclose or suggest the specific combination of claim 36. For example, QRRP1 does not disclose “posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria”, as recited in claim 36. In contrast to claim 36, QRRP1 is a USPTO

quality review sheet comprising a paper input form. Further, the QRRP1 states, “its purpose is only that of an aid in highlighting the particular problem area in the reexamination proceeding.” See QRRP1, paragraph 1. Accordingly, QRRP1 is directed to only “quality review” in the “reexamination proceeding.” QRRP1 discloses the requirement of user input by answering questions 1-8 related to deficiencies in the reexamination proceeding. *See Action*, page 10. However, a quality review of an examination proceeding as disclosed by QRRP1 does not disclose “posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 36. In contrast to claim 36, QRRP1 does not display any type of infringement criteria for a particular patent.

As discussed above, the Office stated that patent infringement and the reexamination procedure are related and that “[a] main reason why reexamination exists is because of patent infringement suits, and the results of reexamination procedure has a direct bearing on pending infringement suits.” *See Action*, page 21, paragraph 13. However, the result of the reexamination procedure is not determinative of whether or not patent infringement exists. Likewise, the result of a patent infringement suit is not determinative of the results of a reexamination process.

QRRP1 discloses questions pertaining to whether a reexamination proceeding is considered deficient. *See QRRP1*, questions 1-8. Reexamination is a procedure conducted when a question of patentability exists, which has a different purpose and analysis to that of identifying an infringement target of a valid patent. QRRP1 does not pertain to identifying an infringement target, but rather pertains to reexamination. Moreover, QRRP1 only allows entry of a single Control Number. The QRRP1 does not disclose “a particular patent” and “an infringement target”, as recited in claim 36. In addition, OmniForm does not disclose or suggest the elements of claim 36 not disclosed by QRRP1. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See OmniForm*, p. 1, paragraph 1.

Further, neither QRRP1 nor OmniForm disclose or suggest evaluating the infringement submission based on the first user input and the second user input, as recited in claim 36. Still even further, QRRP1 is a form including questions pertaining to whether a reexamination

proceeding is considered deficient. *See* QRRP1, questions 1-8. QRRP1 does not address evaluating an infringement submission. In contrast to claim 36, QRRP1 discloses questions pertaining to whether a reexamination proceeding of a single patent is considered deficient. *See* QRRP1, questions 1-8. Any comments/explanations are related to that single patent. Accordingly, QRRP1 does not disclose “evaluating the infringement submission based on the first user input and the second user input”, as recited in claim 36. Rather, any input by QRRP1 is related to that single patent subject to the reexamination procedure. Further, OmniForm does not disclose or suggest these elements of claim 36. Instead, OmniForm discloses a way to convert paper forms to electronic forms. *See* OmniForm, p. 1, paragraph 1. Therefore, QRRP1 and OmniForm, taken separately or in combination, fail to disclose each and every element of claim 36. Hence, claim 36 is allowable.

## VI. Claims 6, 19 and 29 are Allowable

The Office has rejected claims 6, 19 and 29, at paragraph 10 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRP1, and further in view of BountyQuest Website (“BountyQuest”). Applicants respectfully traverse the rejections.

As explained above, OmniForm and QRRP1 do not disclose all of the elements of claim 1. BountyQuest does not disclose or suggest the elements of claim 1 not disclosed or suggested by OmniForm and QRRP1. For example, BountyQuest does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, BountyQuest is directed at invalidating a patent by identifying prior art that does predate the filing of a particular patent. *See* BountyQuest website, p. 9. As stated by the Office, “[i]nfringement of a patent can only occur if the claimed ‘infringement target information’ does not predate the filing date of the particular patent.” *See* Action, page 22. Accordingly, BountyQuest does not disclose “infringement target information” because prior art identified by BountyQuest cannot infringe a patent but prior art can invalidate a patent. Moreover, the corresponding text input adjacent to the “criteria for invalidity” of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See*

BountyQuest, p. 16. However, BountyQuest does not disclose “posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 1. Therefore, OmniForm, QRRP1, and BountyQuest, separately or in combination, do not disclose each and every element of claim 1, or of claims 6 and 19, which depend from claim 1. Therefore, claims 6 and 19 are allowable.

Further, the dependent claims recite additional features not disclosed by the cited references. For example, QRRP1 does not disclose that each claim limitation is associated with one of a plurality of display portions and one of the plurality of input boxes, as recited in claim 6. In contrast to claim 6, QRRP1 presents questions pertaining to deficiencies in a reexamination, and has no display portions or input boxes associated with claim limitations. *See QRRP1, questions 1-8.* Further, the Office states that OmniForm does not disclose this element of claim 6. BountyQuest, in contrast to claim 6, includes a form in which a user supplies information about prior art that may invalidate a particular patent, and not criteria for infringement of a particular patent, as recited in claim 6. *See* BountyQuest, p. 16. For this additional reason, claim 6 is allowable.

Further, QRRP1 does not disclose sending, to the user, a message to acknowledge receipt of the infringement submission, the message indicating the date and the time associated with the infringement submission, as recited in claim 19. Instead, QRRP1 is a form pertaining to whether a reexamination proceeding is considered deficient. *See QRRP1, questions 1-8.* Further, the Office states that OmniForm does not disclose this element of claim 19. In contrast to claim 19, BountyQuest pertains to submitting prior art that predates a particular patent and may invalidate a patent. *See* BountyQuest website, p. 9. However, BountyQuest does not serve to identify infringers of valid patents. For this additional reason, claim 19 is allowable.

As explained previously, OmniForm and QRRP1 do not disclose all of the elements of claim 24. BountyQuest does not disclose or suggest the elements of claim 24 not disclosed or suggested by OmniForm and QRRP1. For example, BountyQuest does not disclose a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user

input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, BountyQuest is directed at invalidating a patent and identifying prior art that predates a particular patent. *See* BountyQuest, p. 9. Therefore, OmniForm, QRRP1, and BountyQuest, taken separately or in combination, do not disclose each and every element of claim 24, or of claim 29, which depends from claim 24. Therefore, claim 29 is allowable.

## **VII. Claims 10-11, 14-17, and 20 are Allowable**

The Office has rejected claims 10-11, 14-17, and 20, at paragraph 11 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over OmniForm in view of QRRP1, and further in view of Utsumi. Applicants respectfully traverse the rejections.

As explained previously, OmniForm and QRRP1 do not disclose or suggest each element of claim 1. Utsumi does not disclose the elements of claim 1 not disclosed by OmniForm and QRRP1. For example, Utsumi does not disclose “posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 1. In contrast to claim 1, Utsumi discloses a website that displays an application number, an unexamined publication number, a registration number, the patent holder’s name, a technical field, an abstract, and claims of the patent. *See* Utsumi, column 4, lines 16; Figure 2. Utsumi does not disclose displaying “criteria for infringement of a particular patent”, as recited in claim 1. Rather, Utsumi discloses an information input window to receive information about an infringer. *See* Utsumi, column 5, lines 49-51. In contrast to claim 1, Utsumi does not disclose a “user input to describe how the infringement target meets the criteria” as recited in claim 1. In fact, Utsumi does not disclose any “criteria for infringement of a particular patent” as recited in claim 1. Therefore, the combination of OmniForm, QRRP1, and Utsumi fails to disclose or suggest each and every element of claim 1, or of claims 10-11, 14-17, and 20, which depend from claim 1.

Further, the dependent claims include additional features not disclosed by the references. For example, neither QRRP1, OmniForm nor Utsumi disclose or suggest that compensating the user is conditioned on a deal with an infringement target, as recited in claim

15, or that compensating the user comprises providing the user a fee commensurate with compensation from a deal with the infringement target, as recited in claim 17. The Office states that OmniForm does not disclose these elements. Moreover, in contrast to claims 15 and 17, QRRP1 is a form to record deficiencies in a reexamination proceeding. In further contrast to claims 15 and 17, Utsumi discloses that an amount of a reward for information provided may be determined by patent attorneys and lawyers evaluating the information for effectiveness in substantiating the infringement, or that the amount may be a fixed fee. *See Utsumi, paragraph 0044.* Thus, in Utsumi, compensation may be determined by an evaluation of the potential effectiveness in an infringement suit, rather than conditioned on a completed deal with the infringement target, or commensurate with compensation from a completed deal with the infringement target. For at least this additional reason, claims 15 and 17 are allowable.

### **VIII. Claims 1-7, 9-22, and 24-36 are Allowable**

The Office has rejected claims 1-7, 9-22, and 24-36, at paragraph 12 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over Utsumi in view of BountyQuest. Applicants respectfully traverse the rejections.

None of the references, including Utsumi and BountyQuest, disclose or suggest the specific combination of claim 1. For example, as explained previously regarding claims 10-11, 14-17, and 20, Utsumi does not disclose “posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 1. In contrast to claim 1, Utsumi discloses a website that displays an application number, an unexamined publication number, a registration number, the patent holder’s name, a technical field, an abstract, and claims of the patent. *See Utsumi, column 4, lines 16; Figure 2.* Utsumi does not disclose displaying “criteria for infringement of a particular patent”, as recited in claim 1. Rather Utsumi discloses an information input window to receive information about an infringer. *See Utsumi, column 5, lines 49-51.* In contrast to claim 1, Utsumi does not disclose a “user input to describe how the infringement target meets the criteria” as recited in claim 1. In fact, Utsumi does not disclose any “criteria for infringement of a particular patent” as recited in claim 1. Still even further, BountyQuest does not disclose posting an electronic form that

displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 1. In contrast to claim 1, BountyQuest is directed at invalidating a patent by identifying prior art that does predate the filing of a particular patent. *See* BountyQuest, p. 9. As stated by the Office, “[i]nfringement of a patent can only occur if the claimed ‘infringement target information’ does not predate the filing date of the particular patent.” *See* Action, page 22. Accordingly, BountyQuest does not disclose “infringement target information” because prior art identified by BountyQuest cannot infringe a patent but prior art can invalidate a patent. Moreover, the corresponding text input adjacent to the “criteria for invalidity” of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See* BountyQuest, p. 16. However, BountyQuest does not disclose “posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 1. Therefore, Utsumi and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 1, or of claims 2-7, 9-22, and 35 which depend from claim 1. Accordingly, claims 2-7, 9-22 and 35 are allowable over the combination of Utsumi and BountyQuest.

None of the references, including Utsumi and BountyQuest, disclose or suggest the specific combination of claim 24. For example, Utsumi does not disclose “a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria”, as recited in claim 24. In contrast to claim 24, Utsumi discloses a website that displays an application number, an unexamined publication number, a registration number, the patent holder’s name, a technical field, an abstract, and claims of the patent. *See* Utsumi, column 4, lines 16; Figure 2. Utsumi does not disclose displaying “criteria for infringement of a particular patent”, as recited in claim 24. Further, Utsumi discloses an information input window to receive information about an infringer. *See* Utsumi, column 5, lines 49-51. In further contrast to claim 24, Utsumi does not disclose a “user input to describe how the infringement target meets the criteria” as recited in claim 24. Utsumi does not disclose any “criteria for infringement of a particular patent” as recited in claim 24. Still even further, BountyQuest does not disclose an electronic form that

displays criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 24. In contrast to claim 24, BountyQuest is directed at invalidating a patent by identifying prior art that does predate the filing of a particular patent. *See* BountyQuest, p. 9. As stated by the Office, “[i]nfringement of a patent can only occur if the claimed ‘infringement target information’ does not predate the filing date of the particular patent.” *See* Action, page 22. Accordingly, BountyQuest does not disclose “infringement target information” because prior art identified by BountyQuest cannot infringe a patent but prior art can invalidate a patent. Moreover, the corresponding text input adjacent to the “criteria for invalidity” of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See* BountyQuest, p. 16. Accordingly, BountyQuest does not disclose “an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 24. Therefore, Utsumi and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 24, or of claims 25-34, which depend from claim 24. Therefore, claims 24-34 are allowable.

None of the references, including Utsumi and BountyQuest, disclose or suggest the specific combination of claim 36. For example, Utsumi does not disclose posting an electronic form that displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not predate the filing date of the particular patent, as recited in claim 36. In contrast to claim 36, Utsumi discloses a website that displays an application number, an unexamined publication number, a registration number, the patent holder’s name, a technical field, an abstract, and claims of the patent. *See* Utsumi, column 4, lines 16; Figure 2. Utsumi does not disclose posting an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 36. Rather, Utsumi discloses an information input window to receive information about an infringer. *See* Utsumi, column 5, lines 49-51. In further contrast to claim 36, Utsumi does not disclose a “user input to describe how the infringement target meets the criteria” as recited in claim 36. Utsumi does not disclose any “criteria for infringement of a particular patent” as recited in claim 36. Still even further, BountyQuest does not disclose an electronic form that displays criteria for infringement

of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited in claim 36. In contrast to claim 36, BountyQuest is directed at invalidating a patent by identifying prior art that does predate the filing of a particular patent. *See* BountyQuest website, p. 9. As stated by the Office, “[i]nfringement of a patent can only occur if the claimed ‘infringement target information’ does not predate the filing date of the particular patent.” *See* Action, page 22. Accordingly, BountyQuest does not disclose “infringement target information” because prior art identified by BountyQuest cannot infringe a patent but prior art can invalidate a patent. Moreover, the corresponding text input adjacent to the “criteria for invalidity” of BountyQuest receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See* BountyQuest, p. 16. However, BountyQuest does not disclose “an electronic form that displays criteria for infringement of a particular patent”, as recited in claim 36. Therefore, Utsumi and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 36. Therefore, Utsumi and BountyQuest, taken separately or in combination, fail to disclose or suggest each and every element of claim 36. Accordingly, claim 36 is allowable.

Further, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest a motivation to modify Utsumi to include the teachings of the BountyQuest website. The Action stated that an inventor would seek out prior art to invalidate his own patent to determine whether to file an infringement lawsuit. *See* Action, page 24. However, there is no suggestion, motivation or teaching in the references to support combining the teachings of BountyQuest with Utsumi. Further, an inventor holding a valid and enforceable patent, which has passed the rigorous examination process by the Patent Office, will not be persuaded not to file an infringement lawsuit because of prior art that is potentially found after the patent has issued.

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.

*ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Utsumi discloses a system to solicit information from third parties to identify potential infringers of intellectual property rights and to reimburse a third party for contributing such information. *See* Utsumi, Abstract. “Infringement of a patent can only occur if the ‘claimed target information’ does not predate the filing date of the patent.” *See* Action, page 22. However, the BountyQuest website discloses a system to solicit information from third parties to invalidate patents by the submission of prior art that does predate the filing date of a particular patent. *See* BountyQuest, p. 3. It would not have been obvious to modify the infringer identification system of Utsumi to include the teachings of the prior art solicitation system of the BountyQuest website. The combination represents impermissible hindsight reconstruction, and should be withdrawn.

Moreover, the infringer identification system of Utsumi teaches away from the prior art solicitation system of the BountyQuest website. The infringer identification system of Utsumi is directed to enforcement of intellectual property rights, while the prior art solicitation system of the BountyQuest website is directed to preventing enforcement of intellectual property rights. Soliciting invalidating prior art information, as taught by the BountyQuest website, frustrates the purpose of the infringer identification system of Utsumi, namely to identify patent infringers, as taught by Utsumi.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

*See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Modifying the patent infringer identification system of Utsumi to include the invalidating prior art solicitation system of the BountyQuest website would render the infringer identification system of Utsumi unsatisfactory for its intended purpose, since the identification of invalidating prior art (as taught by the BountyQuest website) would undermine the enforcement effort associated with infringer identification (Utsumi).

Accordingly, for the reasons presented above, the combination of Utsumi and BountyQuest is improper and should be withdrawn.

## CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

11-16-2007  
Date

  
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